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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,723	10/29/1999	CLAUDE HOPE	BAL6019P0011	6250

32116 7590 05/18/2005

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
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CHICAGO, IL 60661

EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT PAPER NUMBER

1661

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/429,723

Applicant(s)

HOPE ET AL.

Examiner

Anne Marie Grunberg

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 41-65, 73 and 74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41-47, 55 and 56 is/are allowed.
- 6) ☒ Claim(s) 48-54, 57-65, 73-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

PD

### **DETAILED ACTION**

1. Claims 41-65 and 73-74 are pending.
2. The Examiner reminds applicants that a petition to accept color photographs is required as discussed previously.
3. It is understood that Applicant intends to deposit 2500 seeds of inbred line 752 for claim 41 and that hybrid line 3087 has been deposited for claims 59 and 65. Applicant is reminded to amend the specification with regard to the deposit information such as deposit number, date, and address of deposit and to comply with all other deposit criteria.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claim 48 and dependent claims 49-54 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons indicated in the previous office action.

Claim 48 is rejected due to the recitation of “inbred”. An inbred plant is one that is homozygous for all its alleles. At page 5, lines 14-16 of the specification it states that the “inbred” was discovered within a segregating  $F_2$  generation. However, the plants within an  $F_2$  are still segregating and cannot be inbred. As a result, it is unclear what is meant by “inbred”.

***Claim Rejections - 35 USC § 102***

6. Claims 57-59 and 65 and dependent claims 60-64 and 73-74 remain rejected under 35 U.S.C. 102(b) as being unpatentable over Harbaugh et al for the same reasons expressed in the previous office action.

The claims are drawn to Eustoma plants or seeds that are indistinguishable from the plants taught by Harbaugh et al. Claims 57-58 are product by process claims drawn to a Eustoma plant exhibiting reduced apical dominance. Whether at least one ancestor is a claimed plant or not is immaterial because any plant having reduced apical dominance would read on the claims including the plants taught by Harbaugh et al (see page 1057, column 3, lines 12-17, or Table 1). Independent claims 59 and 65 are not limited by the limitation “comprising a recessive allele for reduced apical dominance” and as such are indistinguishable from the prior art when grown under conditions favoring increased basal branching.

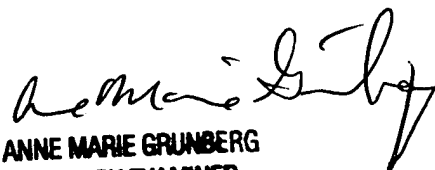
***Conclusion***

7. Claims 41-56 are free of the prior art on account of the particular variety “comprising a recessive allele for reduced apical dominance”. This limitation entails a trait of increased basal branching wherein the branches arise from the cotyledonary node below the first true leaves that branch even under low light conditions.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grünberg whose telephone number is (571) 272-0975. The examiner can normally be reached Monday through Friday from 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax phone number for this group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

  
ANNE MARIE GRUNBERG  
PRIMARY EXAMINER